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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,694	03/22/2004	Katsushi Horihata	P1348US	8737
1218	7590	02/11/2008		
CASELLA & HESPOS 274 MADISON AVENUE NEW YORK, NY 10016				
EXAMINER				
JOHNSON, GREGORY L				
ART UNIT		PAPER NUMBER		
3691				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/805,694

**Applicant(s)**

HORIHATA, KATSUSHI

**Examiner**

GREGORY JOHNSON

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 4, 5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the Applicant's reply filed on November 21, 2007.

### ***Status of Claims***

2. Claims 1-9 were pending. Claims 1,3, 6-7 and 9 have been canceled. Claims 2 and 4 have been amended. Claims 5 and 8 are original. Claims 2, 4-5 and 8 have been examined.

### ***Claim Objections***

3. Applicant has amended claim 4 to remove two minor informalities, therefore the claim objections have been withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Applicant's arguments, see page 6-7, with respect to claims 1-9 have been fully considered and are persuasive. The claim rejections for claims 1-9 have been withdrawn.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2, 4-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Aoki, Pub. No. 2002/0041394 (hereinafter Aoki), in view of Rosen, Pat. No.

6,205,436 (hereinafter Rosen), Kawan, Pat. No. 6,442,532 (hereinafter Kawan) and

Hansmann et al., Pub. No. 2001/0016835 (hereinafter Hansmann).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

As to claim 4, Applicant amended the claim to include the following limitations:  
the server includes:

- a data sending/receiving unit that communicates print data and a document ID with the image forming apparatus;

the image forming apparatus includes:

- a transmitting unit that transmits said document ID to the server;

whereby

- the data sending/receiving unit of the server is operative to communicate with the communications terminal and
- to reads out the print data identified by the document ID from the print data storing unit.

Aoki discloses the above limitations (Abstract; para. 0134 and 0166).

Aoki discloses and Rosen and Kawan teach the invention substantially as claimed as set forth in the previous Office Action.

However, neither Aoki, Rosen nor Kawan disclose the following amended limitation:

- sends the print data to the image forming apparatus in response to receiving from the communications terminal a notification notifying that a certain amount of electronic money equivalent to the price of the print data is subtracted in the communications terminal when the document ID is received from the transmitting unit of the image forming apparatus.

**Examiner's Note:** The Examiner found the above limitation, as written, slightly difficult to understand. For examination purposes, the Examiner has interpreted the above limitation as follows:

- when the document ID is received by the server from the transmitting unit of the image forming apparatus,
- the server sends the print data to the image forming apparatus in response to receiving from the communications terminal a notification notifying that a certain amount of electronic money equivalent to the price of the print data is subtracted in the communications terminal (i.e. proof of payment).

Aoki discloses the 1<sup>st</sup> part of the limitation in para. 0134 (i.e., The printer sends information for requesting corresponding contents data for print-out to the contents server).

Hansmann teaches the 2<sup>nd</sup> part of the limitation. Hansmann teaches a method and system for payment by means of an electronic communications device (e.g. cellular phone). Hansmann teaches that a customer sends receipt of payment to the provider (who is offering the goods and/or services) as proof of payment, and the purchased goods or service is delivered by the provider (para. 0009). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Hansmann within Aoki for the motivation to provide a secure and commonly acceptable payment method for electronic commerce and electronically transacted purchasing (para. 0006).

***Response to Arguments***

9. Applicant's arguments with respect to claims 2, 4-5 and 8 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON  
Examiner  
Art Unit 3691